

REMARKS

This paper is in response to the requirement imposed under 35 U.S.C. §121 and 37 CFR §1.142 for restriction in Paper No. 20050826 dated on the 8th of September 2005, and in further response to the telephonic restriction requirement imposed by the Examiner on 26 August 2005.

Status Of The Claims

After entry of the Amendment After Final filed on 8 August 2005, claims 1 through 13 and 15 through 18 are pending in the application.

The withdrawal of the final rejection of claims 1 and 2 is noted with appreciation.

Requirement For Restriction Under 37 CFR §1.142

Initially on 26 August 2005, the Examiner telephoned Applicant's undersigned attorney and again subsequent to Applicant's written response filed on the 30th of August 2005, in Paper No. 20050826 dated on the 8th of September 2005, required a restriction between:

- Group I: covered by Claims 1 and 4 through 16;
- Group II: covered by Claims 2, 3, 10, 11 and 16; and
- Group III: covered by Claims 7 through 9, 12, 13, 15, 17 and 18.

In response, Applicant again provisionally elects, with traverse, Group II, which includes claims 2, 3, 10, 11 and 16.

Applicant respectfully objects to, and traverses the election requirement on the grounds that the subject matter of the three groups overlap. The mandatory fields of search for the three groups are substantially coextensive. Moreover, it appears that the election requirement is being imposed

merely for administrative convenience and such a basis for imposition of such a requirement has been prohibited in previous decisions of the Commissioner because there is no factual basis on the evidence of record in this prosecution history which justifies the averments that the subject matter of Groups I, II and III “are distinct from each other”¹ As specifically stated in *MPEP* §803, the Examiner must show that the (A) The inventions must be independent (*see MPEP* §802.01, §806.04, §808.01) or distinct as claimed (*see MPEP* §806.05 - §806.05(i)); **and** (B) There must be a **serious burden** on the Examiner if restriction is required (*see MPEP* §803.02, §806.04(a) - §806.04(i), §808.01(a), and §808.02); these requirements have not been met by Paper No. 20050826.

It is respectfully submitted that there would **not be a serious burden** upon the Examiner in searching the invention Group I, Group II and Group III.

Firstly, the Examiner has failed to show any kind of burden. The Examiner has failed to show that the different embodiments are in different classes or that such search would require not just a burden but rise to level of a serious burden. As stipulated in *MPEP* §803, if the search can be made without serious burden, the Examiner **must examine it on the merits** even if there are separate and distinct inventions. The Examiner has not alleged any serious burden during the telephonic conference on 26 August 2005, and thus the Examiner must examine the entire application. Moreover, because no burden was shown, if the restriction is not withdrawn in the next office action, a finality on the restriction requirement cannot be made according to *MPEP* §706.07.

Secondly, as seen above, for example, in Group II, claims 2, 3, 10, 11 and 16 are also in

¹ Examiner’s comments, page 2, Paper No. 20050826.

Group III. Rising to level of a *serious* burden is seriously suspect, especially in light of the generic claims involved. Therefore, there would be no serious burden on the Examiner and as required by *MPEP* §803, the Examiner must examine the entire application on the merits.

Thirdly, the requirement is improper under current U.S. restriction practice, because the requirement is untimely. Under 37 CFR §1.146²,

“[i]n a first action on an application containing a generic claim to a generic invention (genus) and more than one patentably distinct species embraced thereby, the examiner may require the applicant ... to elect a species”

There have been two Office actions issued prior to the telephonic restriction requirement of 26 August 2005. Moreover, a requirement for restriction should be imposed under 37 CFR §1.142 prior to a first action on the merits, and not, as here, after substantive examination on the merits. No claims were added in Applicant's response filed on the 4th of August 2005, and therefore, there is no evidence in the record of independent and distinct subject matter being presented by Groups I, II and III. Furthermore, the pending claims have already been examined on the merits. There is no reason at this stage of the compacted examination to now impose a requirement for an election of species. Its withdrawal is respectfully requested.

If the requirement for restriction is not removed, then the Applicant reserves the right to petition the requirement, because there is no *serious* burden upon the Examiner in searching the invention Group I, Group II and Group III.

²

37 CFR §1.146

Therefore, the Applicant respectfully submits that the restriction requirement should be removed.

In view of the above, it is requested that the election requirement be withdrawn. It is further submitted that the application is in condition for examination on the merits, and early allowance is requested.

No fee is incurred by this Response.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. E. Bushnell', written over a horizontal line.

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